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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,352	02/11/2005	Rudolf Braungardt	BRAUNGARDT ET AL I PCT	6314
25889	7590	03/27/2006	EXAMINER HECKENBERG JR, DONALD H	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			ART UNIT 1722	PAPER NUMBER
DATE MAILED: 03/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/524,352	Applicant(s) BRAUNGARDT ET AL.	
	Examiner Donald Heckenberg	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the Applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (c) BRIEF SUMMARY OF THE INVENTION.
- (d) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (e) DETAILED DESCRIPTION OF THE INVENTION.
- (f) CLAIM OR CLAIMS (commencing on a separate sheet).

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(g) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

2. The disclosure is objected to because of the following informalities: the specification at p. 2, l. 12 refers directly to the claims. The specification should not refer directly to the claims as the claims may change during prosecution of the application. Appropriate correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 5, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 2 recites that the relief structures are "preferably less than 0.8 mm." Such language renders the claim indefinite as it is unclear if the limitation is intended to be required, or just exemplary. Appropriate clarification and correction is

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required. The similar use of a phrase introduced by "preferably" in claim 5 renders that claim indefinite as well.

Claim 10 recites "the clear cross-section of the mold cavity" in line 2. There is no antecedent basis for this limitation in the claim. As such, it cannot be related to the previously defined apparatus structure, thereby rendering the claim indefinite.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (U.S. Pat. No. 6,464,199).

Initially it is noted that claim 1 of the instant application does not include a traditional transitional phrase such as "comprising." As the claims begins by reciting a "molding insert," and the structural features of the insert

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appear to begin at line 7, the transition between preamble and body of the claim will be interpreted as beginning after the "wherein" in line 7.

Johnson discloses molds for producing masonry units. The apparatus includes a molding insert structure (10) having mold cavities (12). In the embodiment depicted in Figures 8 and 9, the walls (14) of the mold cavities have relief structures (18). The relief structures have a convex/concave shape to form the equivalent of "holding flanks" that drop down to the center of the mold cavity (see Fig. 9 in particular). The relief structures run in a strip shape predominantly horizontally, and are disposed in several strips vertically from one and another (see Fig. 8). As further shown in Figures 8 and 9, a prismatic wall segment is formed at the upper end of the mold wall, with the relief structures set back relative to the prismatic wall surface on the lower half of the wall. Johnson further notes that configurations of the relief structures can be 0.03 inches (0.762 mm) deep (cl. 8, ll. 56-68).

Claim 1 recites that the relief structures are "coordinated with the volume of the mold cavity and the material of the molded body, in such a manner that on the one hand, the inherent weight of the molded body is not sufficient to de-mold the latter from the mold cavity and, on the other hand, the molded

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body can be de-molded from the mold cavity, under the influence of the pressure device, without shearing off the projections that are located in depressions of the relief on lateral surfaces of the molded body." This limitation is dependent on the molding material used with the claimed molding insert, as well as the manner in which of the molding insert is used. For example, the density and strength of the molding material and time when the product is removed from the mold would be determinative of the recited limitation. It is well settled, however, that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. Moreover, expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963); In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935); MPEP § 2115. In this case, the apparatus disclosed by Johnson has all of the structural features of the claimed molding insert as described above. As such, the reference anticipates the molding insert apparatus claims of the

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instant application, regardless of the limitations dependent on the molding material and use.

Claim 12 recites that the walls of the mold cavities are hardened. Written as such, this limitation only relates to how the recited mold insert is made. The patentability of a product (in this case, the molding insert) does not depend on its method of production. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); MPEP § 2113. In this case, Johnson discloses the molding insert with all of recited structural features, and as such, anticipates the claim regardless of the manner in which the claimed insert is made.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

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establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Long (U.S. Pat. No. 3,095,629).

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Johnson discloses the molding insert as described above. Johnson does not disclose the walls of the molding insert to comprise additional depressions for spacer elements to be molded into the molded body. However, it is recognized in the art that depressions can be provided on the walls of molds for providing the corresponding shape in the molded product. Long, for example, discloses an apparatus for making masonry blocks wherein depressions (56) are vertically provided and open towards the bottom of the mold walls to provide the corresponding shape into the molded product (see Figs. 4, 5, and 10). As such, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the molding insert disclosed by Johnson as such to have further provided additional depressions in the walls of the mold insert because this would allow for the corresponding shape to be imparted to the molded product as suggested by Long. Note further, such a modification requires the mere change in shape of the apparatus. Normally, a change in the form or shape of a prior art structure is seen as an obvious modification to one of ordinary skill in the art unless it can be shown there is a new and unexpected result. In re Dailey, 357 F.2d 669, 672-73, 149 USPQ 47, 50 (CCPA 1966).

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11. The following reference cited but not relied upon is deemed pertinent to the instant application:

Wittke (U.S. Pat. No. 2,532,049) discloses a mold for making hollow concrete blocks.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions

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on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at (866) 217-9197 (toll-free).



Donald Heckenberg
Primary Examiner
A.U. 1722

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